

Application Serial No. 09/901,013
Reply to Office Communication dated April 13, 2006

REMARKS

In response to the Office Communication dated April 13, 2006, Applicant submits this amendment in which claims 97 to 115, submitted with the Request for Continued Examination, are withdrawn. In this response claims 80, 82-83 and 92-96 are brought back. Claim 81 is canceled. New claims 97 to 104, which depend either directly or indirectly from claims 80 and 92 are submitted. Claims 80 and 92-96 are amended to better define Applicant's invention. Reconsideration of this application in view of the reinstatement of amended claims 80 to 96 and the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 112, second paragraph:

Claims 80-83 and 92-96 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was asserted that claims 80 and 92 are vague and confusing because it is not clear how the sample or tissue is related to the robotic system. Applicant respectfully refers the examiner to Figure 7 of the application, which illustrates the relationship of the tissue sample and transducers as they are moved from a first, a second and subsequent reaction chambers to effect fixation of a tissue sample. New claims 97-100 are directed to system where the fixative solutions used in each subsequent reaction chamber used in the method are defined. Applicant respectfully asserts that the present claims make clear the relationship between the tissue sample, the transducer and the reaction chambers for fixing the sample and respectfully ask that the outstanding rejection be withdrawn as it may be applied to the amend claims and to the new claims.

Rejections Under 35 U.S.C. § 112, first paragraph:

Claims 92-96 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. It was asserted that "systems of robotics" were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. Applicant respectfully asserts that one of skill in the art of the processing clinical tissue samples would readily understand that the automated operations carried out by the

robotic system of the present application could readily be carried out by "systems of robotics."

Nevertheless, the term "systems of robotics" is deleted in the newly submitted claims.

Applicants respectfully ask that this rejection under 35 U.S.C. §112, first paragraph, be withdrawn as it may be applied to amended claims 80-96 and to new claims 97-104.

Claims 80 -83 and 92-96 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that there is no literal support for a system of robotics in the originally filed specification, nor is there support for a plurality of robotics. This rejection is traversed as it may be applied to amended claims 80-96 and to new claims 97-104.

The use of robotic systems in clinical labs for processing tissue samples was well known at the time the present application was filed as demonstrated by the patents and other materials previously submitted in the response filed on October 7, 2005. It has long been the law that it is not necessary to spell out every detail of the invention in the specification; only enough description must be included to convince a person of skill in the art that the inventor possessed the subject matter of his claims. A claim does not lack written description support simply because embodiments of the specification do not contain explicit descriptions of elements that are known to those of skill in the relevant art. Patent specifications are written for the person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. *In re GPAC Inc.*, 57 F. 3d 1573, 1579 (Fed. Cir. 1995).

"The written description requirement states that the patentee must describe the invention; it does not state that every invention must be described in the same way." *Capon v. Eshhar v. Dudas*, 418 F.3d 1349, 1358 (Fed. Cir. 2005). As each field evolves, the balance also evolves between what is known and what is added by inventive contributions. The novel process for fixation of tissues disclosed in the present application can be readily adapted to use with an automated robotic system as described in Example 6 of the application. One of skill in this art would have been readily able to adapt one or more of the known robotic systems for use with the present method of fixation of a tissue sample to achieve the improved results provided by embodiments of the present invention. Accordingly, Applicant respectfully asks that the rejection under the first paragraph of Section 112 be withdrawn as it may be applied to the newly submitted claims.

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Conclusion:

It is submitted that amended claims 80 - 96 and new claims 97 - 104 are in condition for allowance when considered in view of the comments made above. A timely notice to that effect is earnestly solicited.

Respectfully submitted,

By 

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